



Atty. Dkt. No. 086142-0629

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tomotoshi SENOH et al.
Title: SEAT WEIGHT MEASURING DEVICE
Appl. No.: 10/822,706
Filing Date: 4/13/2004
Examiner: Kayes, Sean Phillip
Art Unit: 2841
Confirmation Number: 2928

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal in response to the Final Office Action that was mailed on April 26, 2006.

Remarks begin on page 2 of this document.

REMARKS

The Final Office Action that was mailed on April 26, 2006 has been reviewed and the Examiner's comments have been carefully considered. Claims 1-13 stand rejected and are submitted for reconsideration.

Claims 1-13 are rejected under 35 § U.S.C. 103(a) as being unpatentable over U.S. Patent 6,323,444 ("Aoki"). The rejection should be withdrawn because Aoki fails to disclose, teach, or suggest the claimed invention.

Claim 1 recites the feature "wherein the device is configured so that the weight of the seat is applied between the at least one support point and the sensor point." As pointed out in the Final Office Action, Aoki does not disclose a device configured so that the weight of the seat is applied between the at least one support point and the sensor point. (Paragraph number 3 on page 3 of the Final Office Action.) It is then asserted that:

[i]t would have been obvious...to switch the position at which the weight of the seat acts, from one pin to the other. Such a change would be a mere rearrangement of parts.

The suggest or motivation for do so would be to change to apply (sic) a different force at the sensor position. This would allow the invention to adjust the force applied at the sensor position to be within an ideal range.

It is respectfully submitted that this is an improper basis of rejection. The basis of rejection is grounded in the use of case law for providing support for an obviousness rejection. MPEP § 2144.04 specifically provides two cases for supporting an obviousness rejection based on the mere rearrangement of parts. MPEP § 2144.04 cites:

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice.).

However, the MPEP § 2144.04 also clearly states:

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court....If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

The facts of this application are not similar to either *In re Japikse* or *In re Kuhle* because, in those cases, the particular rearrangement of parts would not have changed the operation of the device. In the present application, the proposed rearrangement of Aoki would change the operation of the device because the rearrangement would alter the bending motion of the resilient arm and the weight measurement is based on the bending motion of the arm. This change is not a trivial one that has no bearing on the operation of the sensor but is one that changes the fundamental mechanism in which the sensing is based. Thus, the proposed rearrangement of Aoki is not similar to changing the position of a starting switch as in *In re Japikse* or changing the placement of a contact as in *In re Kuhle*. Because the present rejection is not similar to the case law in the MPEP, the rejection, which is based solely that case law, is inappropriate.

In the "Response to Arguments" section of the Final Office Action, the rebuttal argument is made that the weight measurement is not based on the bending motion of the resilient member but rather the sensor plate. (Paragraph number 5 on page 8 of the Final Office Action.) Using this logic, the assertion is made that the argument that the rearrangement of parts causes a fundamental change is not persuasive as it fails to show how the suggested change fundamentally changes the mechanism in which the sensing is based. It is respectfully submitted that the bending arm is a fundamental change to the sensing mechanism because the sensor plate receives data through the bending arm. The sensor plate is configured to detect weight based on the movements of the bending arm. If the bending arm is altered, the sensor plate is necessarily altered because of the changed nature in the movements of the bending arm. Thus, any changes to the bending arm necessarily affect the readings of the sensor plate which affects the weight seat measurement.

In view of the fact that it is inappropriate to solely rely on the case law to support the obviousness rejection, it is recognized in the MPEP § 2144.04 that:

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims...is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In the Office Action, there is no reference in the prior art for a motivation or reason to modify the device of Aoki. The only motivation that is provided in the Office Action is that changing the position of the application of force would cause a change in the application of force at the sensor position so that the force could be within an ideal range at the sensor position. This suggestion is not found in any of the cited prior art. Indeed, Aoki makes no mention of such a motivation for altering the movements of the bending arm. This argument has been presented in the previous reply dated March 20, 2006, but has not been addressed in the Final Office Action. Thus, a final rejection is improper at this time.

Furthermore, the proposed motivation is inaccurate because the movement of the application of force to a point between the support point and the sensor point would alter the entire bending direction of the resilient arm (as discussed above) and not merely change the amount of force applied at the sensor point. This argument has been presented in the previous reply dated March 20, 2006, but has not been addressed in the Final Office Action. Instead, in the "Response to Arguments" section of the Final Office Action, a rebuttal argument is presented in the form of providing a different motivation. This new motivation comprises the assertion that there are many type of seats in many types of cars and "it would have been obvious to one skilled in the art to switch the position of the pins, such that the weight force acting on the sensor plate is reversed, and adjusting the strain gauges to an appropriate position to compensate, i.e. turning the plate upside down so that the bending action of the plate would be substantially unaltered." (Paragraph number 5 on page 8 of the Final Office Action.)

This new motivation provided in the Office Action is improper for two reasons. First, this new motivation effectively creates a new rejection that was not necessitated by amendment. Thus, a final rejection is improper. Second, there is no reference disclosing the narrow seat space as a reason for switching the position of the pins except in the disclosure of the present application. Thus, the obviousness rejection is based upon the use of improper hindsight reasoning because the rejection does not take into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made but only includes knowledge gleaned only from the disclosure of the present disclosure.

In the "Response to Argument" section of the Final Office Action, a rebuttal argument is also made that the invention of Aoki is clearly intended to be modified to fit more than one

style of car because of the various embodiments shown in Figures 9-13 of Aoki and it would have been obvious modify the structure of Aoki so that it fits in different seat types. Although Figures 9-13 show different embodiments of the seat weight device of Aoki, these figures merely show different shapes of the bending arm but do not show a different pin support structure. Thus, one with ordinary skill in the art would not be motivated by the various embodiments in Figures 9-13 to use different supporting pin structures.

Furthermore, the motivation of modifying the device of Aoki so that the device can be used to fit different seat types is improper because this new motivation effectively creates a new rejection that was not necessitated by amendment. Thus, a final rejection is improper.

Because the reliance on case law for supporting the obviousness rejection is inappropriate, there is no teaching from the prior art of the application of force being between the supporting point and the sensor point, and there is no reason or motivation from the prior art to move the application of force to a point between the supporting point and the sensor point, claim 1 is not rendered unpatentable over the teachings of Aoki.

Dependent claims 2-6 depend from claim 1 and are allowable therewith for at least the reasons set forth above without regard to the further patentable limitations contained therein.

Claim 7 recites the limitation “the pin bracket is located between the base pin and the load sensor.” As mentioned in the Office Action, Aoki does not teach this feature. (Paragraph number 9 on page 4 of the Office Action.) The Office Actions states that moving the pin bracket is a mere arrangement of parts and the suggestion or motivation to change its location would be to adjust the force applied to the sensor position so that it can be within an ideal range.

As previously mentioned, the reliance solely on case law for supporting an obviousness rejection in this instance is inappropriate. The cases cited by the MPEP are not similar to the present application because the movement of the pin bracket changes the operation of the device, which is inconsistent with the case law provided in the MPEP supporting the rationale for a mere arrangement of parts.

In addition, there has been no motivation or suggestion from the prior art to move the pin bracket. As set forth above, the proposed motivation for moving the application of force is inaccurate.

Furthermore, the assertion that it would have been obvious to switch the position of the pins given the narrow seat space is improper because it is a new rejection that was not necessitated by amendment, is not based on any teaching found in the prior art, and is based upon improper hindsight reasoning.

The assertion that the invention of Aoki is clearly intended to be modified to fit more than one style of car because of the various embodiments shown in Figures 9-13 of Aoki is improper because Figures 9-13 merely show different shapes of the bending arm but do not show a different pin support structure. Additionally, this motivation of modifying the device of Aoki so that the device can be used to fit different seat types is improper because this new motivation effectively creates a new rejection that was not necessitated by amendment. Thus, a final rejection is improper.

Because the application of case law for supporting the obviousness rejection is inappropriate, there is no teaching from the prior art of the pin bracket being between the supporting point and the sensor point, and there is no reason or motivation from the prior art to move the pin bracket to a point between the supporting point and the sensor point, claim 7 is not rendered unpatentable over the teachings of Aoki.

Dependent claims 8-13 depend from claim 7 and are allowable therewith for at least the reasons set forth above without regard to the further patentable limitations contained therein.

Reconsideration and withdrawal of the rejection based on 1-13 is respectfully requested.

CONCLUSION

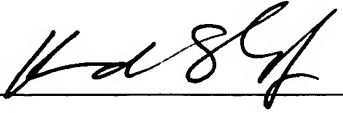
For the aforementioned reasons, claims 1-13 are in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 7/24/06

By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5490
Facsimile: (202) 672-5399

Howard N. Shipley
Attorney for Applicant
Registration No. 39,370